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**THIS DISPOSITION  
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Paper No. 15  
HWR

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Marc S. Cooperman

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Serial No. 75/652,852

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Mark J. Ingber of Waters, McPherson, McNeill, P.C.  
for Marc S. Cooperman.

Douglas M. Lee, Trademark Examining Attorney, Law Office  
108 (David Shallant, Managing Attorney).

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Before Quinn, Hairston and Wendel, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Marc S. Cooperman has filed an application to register  
the mark EMAILER ID for "e-mail processing and presentation  
software used in identifying and authenticating the sender  
of an e-mail."<sup>1</sup>

Registration has been finally refused under Section  
2(e)(1) of the Trademark Act on the ground that the mark,  
as applied to applicant's goods, is merely descriptive

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<sup>1</sup> Serial No. 75/652,852, filed March 3, 1999, based on an  
allegation of a bona fide intention to use the mark in commerce.

thereof. The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. No oral hearing was requested.

The Examining Attorney maintains that the proposed mark EMAILER ID immediately describes an intended feature or function of applicant's software, namely, the identification of the sender of an e-mail message. To support this position, the Examining Attorney has made of record dictionary definitions of the term ID as an abbreviation for "identification,"<sup>2</sup> of the term "e-mail" as "messages sent and received electronically via telecommunication links, as between microcomputers and terminals,"<sup>3</sup> and of the suffix "-er" as "one that performs a specified action."<sup>4</sup> In addition, he has made of record several Nexis excerpted articles showing use of the term "emailer" to refer to the sender of an e-mail.

Representative examples include:

In key markets such as the United Kingdom, the success of subscription-free Internet services ... mean[s] that instead of having to install the complicated access software commonplace just a few years ago, wannabe emailers can just log on, plug and play. *The Hollywood Reporter* (January 25, 2000);

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<sup>2</sup> *The American Heritage Dictionary of the English Language* (3<sup>rd</sup> ed. 1992).

<sup>3</sup> *Id.*

<sup>4</sup> *Id.* While certain of these definitions were not made of record until the Examining Attorney's brief, the Board is always free to take judicial notice of such definitions.

Now complaints are surfacing that Microsoft has been selling lists of Hotmail addresses to bulk emailers - that is spammers. *Seattle Weekly* (September 9, 1999);

Those who purport to know say emailers sent 2.7 million messages in 1997. *Chattanooga Free Press* (January 30, 1998); and

Wired Style: Principles of English Usage in the Digital Age by Constance Hale states that email is now a "closed up" (no space, no hyphen) word that is capitalized only if it starts a sentence. It can also be used as a verb (Email me) or have mutations (emailable, emailer). *Chattanooga Free Press* (October 26, 1997).

Applicant contends that the Examining Attorney has failed to prove that the mark is merely descriptive in that no dictionary definition has been cited for "emailer" per se; no use of the words "emailer ID" has been shown on the Nexis database nor has it been shown that the words as a whole have a recognized meaning; and the usages of "emailers" being relied upon are no more than as a slang term referring to annoying direct mail senders. Applicant further argues that the mark does not immediately convey information to consumers as to the exact nature of applicant's goods; that his software in fact has many purposes; and that there is no evidence that applicant's competitors in the industry have used or needed to use EMAILER ID. Applicant points to copies of four third-party registrations which he has made of record for other marks containing the term ID as evidence that this term has not

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been considered descriptive when used in other composite marks.

A term or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term or phrase is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the designation is being used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods or services bearing the designation, because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary that the term or phrase describe all the characteristics or features of the goods or services in order to be merely descriptive; it is sufficient if the term or phrase describes one significant attribute thereof. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

We find the evidence of record fully adequate to establish that each portion of applicant's mark, EMAILER ID, has a recognized meaning and that applicant's mark as a

whole simply combines these two meanings to obtain the expected connotation, i.e., the identification of a sender of an e-mail message. The dictionary definitions alone are sufficient to show that the meanings of both "emailer" and "ID" would be readily apparent to the general public. The Nexis excerpts demonstrate that "emailer" per se is a known term used to refer to a sender of e-mail. Even if it is slang, although we think the one Nexis article shows "emailer" to be a newly adopted term in the field, this does not detract from the public's general understanding of the term.

Furthermore, we find that EMAILER ID, if used with applicant's software, would immediately convey information to customers as to a significant feature or function of the software. Regardless of other purposes or functions of the software, the software as identified is used in "identifying ...the sender of an e-mail." Applicant has specifically acknowledged that one of the purposes of the software is "enabling the recipient to determine who sent the e-mail." (Brief p.7) This function is clearly described by EMAILER ID. As noted above, it is not necessary that each and every attribute of the software be described, a significant one is sufficient.

Moreover, we do not determine the descriptiveness of the mark in a vacuum, but rather in relation to the goods upon which the mark will be used. The question is not what the mark might mean when used alone, but what it means when used in connection with applicant's software product. The correlation of EMAILER ID and applicant's particular software would be readily obvious.

The fact that there is no evidence of record that applicant's competitors have used the term is of little note. Even if applicant were to be the only user of this term in connection with software of this type, this does not alter the descriptive significance of the term. See *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999); *In re Pharmaceutical Innovations, Inc.*, 217 USPQ 365 (TTAB 1983). As for the third-party registrations containing the term ID as part of the marks, we find the registration of marks in which ID is used in combination with different words and for different goods to be totally irrelevant.

Accordingly, we find EMAILER ID merely descriptive of the e-mail processing and presentation software used in identifying and authenticating the sender of an e-mail with which applicant intends to use the mark.

Decision: The refusal to register under Section 2(e)(1) is affirmed.

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